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FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER SLOAN, NATHAN A	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,353

Applicant(s)

TOGURI, YASUHIRO

Examiner

Nathan A Sloan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Response to Amendment

Applicant's arguments filed 12/4/03 have been fully considered but they are not persuasive.

Applicant has amended independent claims 1, 6, 7, 8, and 16 to remove "contents ID" and asserts that "the Office Action asserted that the 'location' field in Itakura's Fig. 20 contains a URL which the Examiner believes is equivalent to 'contents ID' ..." and that because this limitation has been removed claims are now allowable. However, the examiner did not rely upon the location field to meet "contents ID," rather this was relied upon for a teaching of "general purpose additional information ID" (see p. 4, lines 1-3, paper 13). These elements are claimed in the alternative, and therefore as previously noted the burden on the examiner is only to meet a single element.

With respect to claim 17, applicant states that "it appears that the Office Action has not addressed features" including analyzing a delivery request for data, extracting general purpose additional information of the contents data and individual additional information. In response to claim 17 examiner stated that limitations were "met as noted above" and additionally with regard to specific limitations. Regardless, a user may request data and general purpose additional information is provided as a URL with individual additional information by extracting messages based on user preferences. This is addressed in detail in response to claims 1 and 17 below as previously recited in paper 13.

With respect to claim 5, applicant asserts that Itakura only teaches updating charging information to the providers of the advertisements and states that claim 5 is correspondingly

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distinguishable from Itakura. Examiner clearly stated that this feature is met “as taught in col. 10:59+ through col.11: 8 by relieving a charge from a user based on a connection log” which reads in part “users can access Internet for free on the condition of recognizing messages.” That is, user connection fees are “updated” to be free if they choose to receive messages. These fees that are removed from the user are then paid by advertisers to Internet providers.

Correspondingly, previous grounds of rejection stand as addressed below.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 5-7, 16-17, and 20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Itakura et al., U.S. Patent No. 6,351,745.

Itakura et al. teach a system used in a communication network that allows clients to access information internet over a broadband connection as well as receive messages such as advertisements. User preferences are stored in a user database and advertisements are sent to

users based on their preferences. A billing system is also taught to charge the advertiser based on the advertisements displayed to the user.

With respect to claims 1, 6, 16, and 20, Itakura teaches the claimed information processing apparatus. The claimed “first registration means for registering general additional information regarding said contents data” is met by Itakura’s means to store data and identifying information. In column 8, lines 1-11 Itakura teaches storing data which represents the location of the data requested. This information may also include, for example, a home page address (URL) of a store on the world wide web. Because applicant has claimed a plurality of types of “general additional information” in the alternative, the burden on the examiner is only to satisfy a single element. Therefore, the claimed “general purpose additional information ID” is met by storing in association an ID, such as the above noted URL. This is explicitly taught in column 8, lines 7-11. In this manner, Itakura meets the claimed first registration of “general information” regarding said contents data. The claimed “second registration of additional individual information...” is met by Itakura in the registering of client preferences in item S414 of figure 17. User information such as sex, marriage status, occupation, etc. are stored in the message user database 34 of figure 6. Itakura also teaches that a transmittal condition database 36 can record additional individual information regarding goods that the user has already shown interest in, claimed “on the basis of at least said contents data,” to ensure that suitable advertisements are sent according to user preferences in column 10, lines 48-58. As taught in column 10, lines 21-30, this database stores message URL’s that identify each message and the corresponding transmission conditions. By using the user information to find proper messages, the message URL’s are also “registered” for individual users based on preferences as “additional individual

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information,” as claimed. The claimed storage means for storing said first and second registration information are thus met by the message user database 34 and the transmittal condition database 36. The stored general additional information and additional individual information is extracted using a characteristics reader used to retrieve characteristics from the databases as taught in column 27, lines 48-49. If a user is inactive, messages including general and individual additional information are not sent. Rather, only when “a delivery request for contents data” is received will the message distribution apparatus search and extract required information (col. 15:13-42). The individual additional information “is extracted on the basis of user information comprising at least one of user status and user usage classification” by extracting based on user status, active or idle, and user characteristics, in order to accurately target active users.

Furthermore, the claimed generation means for generating individual data to be transmitted based on the general and individual additional information is met by the message distribution apparatus 39 of figure 1. Itakura teaches receiving a request for contents, followed by the reading of user preferences from said message user database 34 and transmittal condition database 36. Based on user preferences, messages as well as a URL relating to additional information are generated as taught in column 10, lines 31-58. The transmission means for transmitting said contents data, general additional information, and additional individual information is met by Itakura in column 11, lines 60-67 and column 12, lines 1-8. Itakura teaches an internet connection with known communication method and message distribution apparatus 39 for distributing said individual data as messages to a terminal 10 of figure 1. With respect to displaying said contents data, general additional information, and individual additional

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information *simultaneously*, examiner refers applicant to Figures 29 and 33. As seen in Figure 29 and 33 a contents data region 60 is shown, a "Location region" is shown for displaying the claimed "general additional information regarding said contents data," a message viewer window 62 exists to display claimed "individual additional information," which is retrieved as noted above using user database 34 and transmittal condition database. Examiner notes with reference to Figure 12, item 64 of applicant that the "additional information" region includes an "id link to other data," as taught by Itakura with Home Page button 64 that is an ID link to other data regarding the individual data.

With respect to claim 2, the claimed means for recording charging information on the basis of individual data generated is met by Itakura in the message access log 37 as seen in figure 12. Itakura teaches recording information regarding the access of said individual information data in column 1, lines 9-21.

With respect to claim 5, the claimed updating charging information by updating "charges to at least an end user for use of said contents data and/or individual metadata on the basis of said generated metadata" is taught in col. 10:59+ through col.11: 8 by relieving a charge from a user based on a connection log. The connection log indicates what messages are recognized by a user and bills the message provider in order to relieve the user of their connection fee.

With respect to claim 7, the claimed recording medium wherein a program for controlling an information processing apparatus to deliver data over a network is taught by Itakura in the message manager 24. Itakura teaches message viewer software 76 of figure 3 to be installed on the terminal device in a recording medium in column 8, lines 43-67 and column 9, lines 1-3. Itakura further teaches that the recording medium can be a variety of devices such as RAM,

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DVD's, floppy disks, CD-ROM, tap media, semiconductor memory, etc in column 25, lines 5-24. The software in the terminal device is used to communicate with message manager 24 of figure 1 over the internet. The message manager is taught to send and receive messages with the terminal as well as access databases. In this manner the message manager meets the claimed program because it controls the processing of all limitations set forth and addressed in claim 6. With respect to "said contents data, general additional information, and individual additional information are simultaneously displayed on a display screen at said other apparatus," these features are taught as seen in Figures 29 and 34 and noted in response to claim 1.

With respect to claim 17, Itakura teaches delivering messages and additional information to users based on their viewing history, as well as charging message providers in response to the delivery of the messages. As noted above, Itakura teaches receiving a request for a message, followed by the reading of user preferences from said message user database 34 and transmittal condition database 36. Based on user preferences, characteristics including status, and usage history as seen in Figures 7, 8, and 9, claimed user status and classification, the messages suitable for individual viewers are generated. This general purpose additional information is displayed in the message viewer window 62 and as well as a URL link through home page button 64. Although the specific term "metadata" is not used, the generation of individual metadata from general additional information and extracted additional information is taught. Examiner notes that applicant defines metadata as additional information that describes audio and video data on page 1, lines 18-21. This information is taken as commonly defined in the industry to include information such as name, size, data type, length, location, ownership, associations, and a number of other factors that describe contents data. As seen in Figures 11

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and 12, a record is formed with information describing the extracted information including a note as to whether material requests are made. This information is taught to be used to "update charging information on the basis of said generated individual metadata," in column 10, lines 20-38. The claimed transmission of contents data and individual metadata, information describing the audio video contents data, is met as noted above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 4, 8, 10, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itakura as applied to claims 1, 2, and 5-7 above, and further in view of Baji et al., U.S. Patent No. 5,027,400.

With respect to claims 3, 4, 10, 12, and 14 all of the limitations that are reflected in claim 1 as addressed above. Itakura does not teach the first registration means registering information by splitting the contents of data per segment, scene, or object. Furthermore, Itakura teaches the second registration means registering individual additional information with URL addresses but not split per segment, scene, or object as claimed. Baji teaches a cable distribution network used

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to transmit regular programming as well as commercials, claimed additional information, in a television broadcast. Baji explicitly teaches the transferring of desired program and advertisement to the main controller 106 of the head end in column 4, lines 13-17. The main control program then controls the integration of the advertisements with the regular programming, splitting the regular programming up as in claim 3 of applicant and inserting commercial or advertisement scenes as in claim 4 of applicant. The table and method for controlling this process is shown in figure 10 and taught in column 7, lines 46-65. Examiner notes that it is well known in the industry to split up television programs, whether viewed over conventional television or via Internet broadcast, up into scenes with commercials show in between. Furthermore, Itakura teaches in column 9, lines 10-13 that the message viewer may display a new message every predetermined time interval, and the simultaneous display of this message as noted in response to claim 1. Baji similarly teaches splitting a television program with registered commercials at predetermined time intervals as seen in Figures 5A-5P, which splits the program per segment or scene as claimed. It clearly would have been obvious for one skilled in the art at the time to modify the simultaneous displaying of contents data and additional advertising information taught by Itakura by the data stream splitting techniques of Baji in order to integrate advertisements with the regularly viewed content.

With respect to claim 8, Itakura teaches the first apparatus as addressed in response to claim 1 above. Although Itakura teaches receiving and processing a request for data to be transmitted, Itakura does not teach a *second apparatus* having delivery request means so as to transfer said contents data to said first apparatus with means for *integrating* said contents data and said individual data supplied from the first apparatus. Baji teaches a main control unit 106

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for controlling the access of contents data and additional individual data. Baji further teaches a second information apparatus the terminal control unit 113 of figure 1 to be used in conjunction with a delivery request. The commercials may be integrated into the regular contents data by storing commercials in a buffer on the terminal control unit and then integrating them into the regular content data in column 8, lines 30-48. In this manner, Baji teaches a delivery request for contents data by the main control unit, claimed first apparatus, and output means in the terminal unit, claimed second apparatus, for integrating the contents data and individual data. It would have been obvious for one skilled in the art at the time to modify the targeted advertisement apparatus of Itakura with the second apparatus of in order to integrate advertisements with regularly viewed content for the user.

5. Claims 9, 11, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itakura et al. (6,351,745) and Baji (5,027,400), and further in view of Kitsukawa et al. (6,282,713).

With respect to claims 9, 11, 13, and 15 neither Itakura nor Baji explicitly teach splitting registration per object appearing within said contents data. Examiner notes that the use of "hot spots" is well known in the art, and that these systems would read on many of the limitations of claim 1. Hot spots are used to allow the viewer to obtain additional information regarding items in a display. A display is split per object based on items, claimed additional information, with additional individual information consisting of a URL link that provides additional information about the item appearing in within the display. To these means, Kitsukawa et al. (6,282,713) teach an electronic advertising system utilizing hot spots to link users to additional information regarding displayed products. As seen in Figure 5, items containing additional information are

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separated per object and URL information, claimed individual additional information, is registered for each item. As seen in Figure 4, item 410, a user may select an item, claimed "request," and as taught in column 7, lines 34-40 the full advertisement or web link may be displayed simultaneously with the regularly playing programming using well known picture in picture techniques. It would have been obvious for one skilled in the art at the time of the invention to further modify the techniques taught by Itakura and Baji by splitting additional information per object as taught by Kitsukawa in order to provide additional information relating to multiple items displayed in a program that the user may have interest in.

6. Claims 18-19 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itakura et al. (6,351,745).

With respect to claim 18, the claimed general additional information comprising a "time or date of filming a video scene of contents data" is not taught by Itakura. Numerous various ways for describing data are known in the art. Examiner takes Official Notice that it was well known in the art at the time of the invention to store time or date of filming a video scene. It would have been obvious for one skilled in the art at the time of the invention to modify the system of Itakura by storing time or date of filming of a scene in order to provide users of the system with an indication of how recent the filming is.

With respect to claims 19 and 21, Itakura does not teach storing an explanation of a video scene or a part and name covered by additional information. Examiner takes Official Notice that it was well known in the art at the time of the invention to store an explanation of a video scene, part, and name covered by additional information. It would have been obvious for one skilled in the art at the time of the invention to modify the system of Itakura by storing an explanation of a

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video scene in order to provide users of the system with an indication the content of programming.

With respect to claims 23-24, Itakura does not teach general additional information comprising a segment number or object number. Examiner takes Official Notice that it was well known in the art at the time of the invention to utilize segment and object numbers. It would have been obvious for one skilled in the art at the time of the invention to modify the system of Itakura by using segment and object numbers in order to fully describe contents data and facilitate selection.

With respect to claim 25, Itakura does not teach general additional information comprising additional information classification. Examiner takes Official Notice that it was well known in the art at the time of the invention to classify additional information. It would have been obvious for one skilled in the art at the time of the invention to modify the system of Itakura by classifying additional information in order to fully describe contents data and facilitate selection for users.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**


MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan A Sloan whose telephone number is (703) 305-8143. The examiner can normally be reached on Mon-Fri 7:30am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703)305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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